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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/868,845	09/07/2001	Juergen Rolf Mueller	0179-0170P	6312

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EXAMINER	
STOCK JR, GORDON J	

ART UNIT	PAPER NUMBER
2877	

DATE MAILED: 07/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/868,845	MUELLER ET AL.	
	Examiner	Art Unit	
	Gordon J. Stock	2877	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *5/2/06;5/9/06*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *23-38,40-49,51-59,61,62 and 64* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *23-38,40-42,44-49 and 51-59* is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☒ Claim(s) *43,61,62,64* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *05 November 2004* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. The Amendments received on May 2, 2006 and May 9, 2006 have been entered into the record.

Drawings

2. The drawings are objected to because: the drawing received on November 5, 2004 should have 'Figur 6' read –Figure 6--. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3. The abstract of the disclosure is objected to because the abstract exceeds 150 words. Correction is required. See MPEP § 608.01(b).

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the particular phrase of claim 36 "research of active ingredients, functional analysis of combinatoric-chemical or combinatoric-biological synthesis-products, functional genome-analysis, evolutive biotechnology, diagnostics, proteom-analysis, or the investigation of material' lacks antecedent basis in the specification. Examiner suggests amending lines 31-32 page 11 and page 1-2 of page 12 of specification to overcome objection to the specification.

Claim Objections

5. **Claims 43, 61, and 64** are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Specifically, the claims refer to a method, an intended use of the apparatus, found in the preamble of the apparatus base claim. As for the method in the preamble of the apparatus base claim: the recitation in the dependent claims concerning a further step of performing in the method has not been given patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. Kropa v. Robie, 88 USPQ 478 (CCPA 1951). Also since the method in an apparatus claim's preamble is an intended use because the claims state 'apparatus for performing a method' it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed

apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex Parte Masham, 2 USPQ F.2d 1647 (1987).

6. **Claims 62 and 64** are objected to for depending from a cancelled claim, **claim 39**. Examiner has interpreted these claims as depending from **claim 38**, since **claim 39** was cancelled because of it being a substantial duplicate of **claim 38**. See Office Action: 20051029. However, Examiner would like to state that **claim 62** is a substantial duplicate of **claim 59** if it does depend from **claim 38**. And **claim 64** is a substantial duplicate of **claim 61** if it does depend from **claim 38**. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Allowable Subject Matter

7. **Claims 23-38, 40-42, 44-49, and 51-59** are allowed.

Claims 43, 61, 62, and 64 would be allowable if amended to overcome the objection above.

As to **claim 23** the prior art of record, taken alone or in combination, fails to disclose or render obvious in a method of optically detecting at least one entity generating an auxiliary focus by means of at least one second radiation source and a second objective, in combination with the rest of the limitations of **claims 23, 25-36, 44, and 46.**

As to **claim 24** the prior art of record, taken alone or in combination, fails to disclose or render obvious in a method of optically detecting at least one entity the auxiliary focus relative to the interface is moved and the position is adjusted in a manner that the intensity of the

retroreflection reaches its maximum, in combination with the rest of the limitations of **claims 24, 45, 47, 48, 52, 54, 57, and 58.**

As to **claim 37**, the prior art of record, taken alone or in combination, fails to disclose or render obvious in an apparatus for optically detecting at least one entity at least a second radiation source as well as at least one further device comprising a second objective, in combination with the rest of the limitations of **claims 37, 40-43.**

As to **claim 38**, the prior art of record, taken alone or in combination, fails to disclose or render obvious in an apparatus for optically detecting at least one entity means for variation of the convergence of bundles of rays that are focused to generate the auxiliary focus and the measuring volume, in combination with the rest of the limitations of **claims 38, 59, 61, 62, and 64.**

As to **claim 49**, the prior art of record, taken alone or in combination, fails to disclose or render obvious in a method of optically detecting at least one entity obtaining the small extension of the confocal detected volume by a diaphragm having a smaller opening than a confocal arranged diaphragm for the detection of the measuring volume, in combination with the rest of the limitations of **claim 49.**

As to **claim 51**, the prior art of record, taken alone or in combination, fails to disclose or render obvious in a method of optically detecting at least one entity the auxiliary focus is moved both laterally and axially to the optical axis, in combination with the rest of the limitations of **claim 51.**

As to **claim 53**, the prior art of record, taken alone or in combination, fails to disclose or render obvious in a method of optically detecting at least one entity the retroreflection is detected by means of at least two detectors, in combination with the rest of the limitations of **claim 53.**

As to **claim 56**, the prior art of record, taken alone or in combination, fails to disclose or render obvious in a method of optically detecting at least one entity the entities selected are separated during or after the scanning process from the other entities and/or substrates, in combination with the rest of the limitations of **claim 56.**

Response to Arguments

8. Applicant's arguments, see Remarks, filed May 2, 2006, with respect to the previous rejection of claim 55 under 35 U.S.C. 103(a) have been persuasive. Due to the persuasiveness of the argument the previous rejection under 35 U.S.C. 103(a) has been withdrawn. Due to the amendment to the claims the previous rejection (see document 20051029) under 35 U.S.C. 112 second paragraph has been withdrawn. Due to the amendment to the claims the previous objections to the claims (see document 20051029) have been withdrawn. However, in regards to the previous objection of **claims 43, 61, 64** under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Examiner disagrees with arguments filed May 9, 2006 concerning the amendment to the claims to having a step since claims 43, 61, 64 depend from an apparatus claim; wherein, the method being further limited is an intended use of the apparatus as well as in the preamble of the apparatus claim. See objection to **claims 43, 61, and 64** above.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: U.S. Patent 4,935,612 to Bierleutgeb

10. This application is in condition for allowance except for the following formal matters: the objections to the drawings, specification, and claims stated above.

Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.

Fax/Telephone Numbers

If the applicant wishes to send a fax dealing with either a proposed amendment or a discussion with a phone interview, then the fax should:

1) Contain either a statement "DRAFT" or "PROPOSED AMENDMENT" on the fax cover sheet; and

2) Should be unsigned by the attorney or agent.

This will ensure that it will not be entered into the case and will be forwarded to the examiner as quickly as possible.

Papers related to the application may be submitted to Group 2800 by Fax transmission. Papers should be faxed to Group 2800 via the PTO Fax machine located in Crystal Plaza 4. The form of such papers must conform to the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CP4 Fax Machine number is: **(571) 273-8300**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gordon J. Stock whose telephone number is (571) 272-2431.

The examiner can normally be reached on Monday-Friday, 10:00 a.m. - 6:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory J. Toatley, Jr., can be reached at 571-272-2800 ext 77.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private Pair system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HWA (ANDREW) LEE
PRIMARY EXAMINER

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July 18, 2006

Gregory J. Toatley, Jr.
Supervisory Patent Examiner
Art Unit 2877